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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,016	11/16/2001	Kirk Kobmann	OB008DH-1	2966

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EXAMINER	
PICKARD, ALISON K	
ART UNIT	PAPER NUMBER
3676	

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/991,016	KOBMANN ET AL.
	Examiner	Art Unit
	Alison K. Pickard	3676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-24 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-24 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☒ The proposed drawing correction filed on 02 July 2003 is: a)☒ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Note: page 5, line 9 is missing a number.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Larsen '305.

Larsen discloses a non-symmetrical tub having plural fastening features/tabs, and heat expandable material.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1, 3, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takabatake '914.

Takabatake discloses a sealing device comprising a non-symmetrical tub 31 having a locking feature 36 (weldable metal). Heat activated sealant 21 contacts the tub. The tub can be injection-molded (see col. 7, lines 58-60). The seal and sealant contacts at least tree, metallic,

automotive members 1, 2, and 3 (Fig. 2). Takabatake does not disclose plural locking features. Using plural locking features is considered a design choice. See In re Harza 124 USPQ 378 (CCPA 1960). Multiple locking features would enhance the stability of the tub. And, it is known to use plural locking features with a sealing device as evidenced by Larsen. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to use plural locking features as a matter of choice in design.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Larsen.

Larsen does not disclose that the tub is made of polyethylene terephthalate. Making the tub from this material is considered a design choice. It is not considered inventive to select a known material based on its suitability for its intended use. See *In re Leshin,* 125 USPQ 416 (CCPA 1960). Polyethylene terphthalate is a known moldable material (as evidenced by Applicant, spec. page 4). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to make the component from polypropylene as a matter of choice in design.

6. Claims 2, 3, 6, 7, 9-12, 14-16, and 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamuro (5,829,824) in view of Larsen (6,419,305).

Yamamuro discloses three adjacent metallic automotive members 17 (or 15), 4, and 14 that form a cavity (see Fig. 2). The members comprise a floor pan 14, wheelhouse 4, and rail or sheet metal 15. Yamamuro does not disclose a cavity seal/pan extension or heat expandable sealant. Larsen teaches the use of a cavity seal between adjacent automotive members (col. 4, lines 1-16). The seal provides structural reinforcement and damping characteristics (i.e. for noise, dust, etc.). Larsen teaches that the cavity sealer is an injection-molded component shaped

to fit within the cavity formed by the automotive members. The sealer 14 is secured in place within the cavity by integral locking tabs (see Fig. 4) and then is sealingly secured to the members by a heat-activated sealant 16. The sealer 14 comprises a fiber-reinforced thermoset (see col. 9, line 54). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the body structure disclosed in Yamamuro by reinforcing the cavity formed by the three members with the cavity sealer taught by Larsen to reinforce the structure and offer damping characteristics against force, noise, etc.

Regarding claim 10 (and 16), Larsen discloses the component can be made from an injection-molded polymer. However, Larsen does not disclose that the component is formed from polypropylene. Making the component from polypropylene is considered a design choice. It is not considered inventive to select a known material based on its suitability for its intended use. See *In re Leshin,* 125 USPQ 416 (CCPA 1960). Polypropylene is a known rigid material used in sealing components as evidenced by Walser. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to make the component from polypropylene as a matter of choice in design.

7. Claims 12-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamuro in view of Takabatake in view of Larsen.

Yamamuro discloses at least two (three) adjacent metallic automotive members 17 (or 15), 4, and 14 that form a cavity (see Fig. 2). The members comprise a floor pan 14, wheelhouse 4, and rail or sheet metal 15. Yamamuro does not disclose a cavity seal/pan extension or heat expandable sealant. Takabatake teaches a cavity seal comprising a member 31 having a heat expandable sealant 21. The member is non-symmetrical, has a cavity, and an opening (see

between walls 83 in Fig. 6). The member includes a weldable insert 36. Takabatake teaches that the cavity seal is placed in a cavity formed by automotive members and offers damping power and sound insulation. Takabatake does not disclose that the material of the member 31 is a thermoplastic or that it comprises a compressible locking tab. Larsen teaches a cavity sealer that is held in place within a cavity by fasteners (seen in Fig. 4). Larsen also teaches that cavity seal has a member that can be made from a thermoplastic (nylon) material or metal. Thermoplastics can be injection-molded for easy manufacture. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Yamamuro in view of Takabatake and further in view of Larsen to provide a seal with a easily manufactured member that can be effectively mounted and retained within a cavity formed by adjacent auto members to offer damping power and sound insulation.

Regarding claims 16 and 17, Neither Larsen or Yamamuro disclose the sealant is ethyl vinyl acetate or that the thermoplastic is one of polyester, polypropylene or polyethylene terephthalate. Making the items from these materials is considered a design choice. It is not considered inventive to select a known material based on its suitability for its intended use. See *In re Leshin,* 125 USPQ 416 (CCPA 1960). These materials are known to be used for sealing elements in automobiles as evidenced by Walser and Hanley '260. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to make the sealant from ethyl vinyl acetate and to select the thermoplastic from one of polyester, polypropylene or polyethylene terephthalate as a matter of choice in design.

Response to Arguments

8. Applicant's arguments filed 7-2-03 have been fully considered but they are not persuasive.

Takabatake discloses the component can be made of metal OR injection molded. Also, while not used above, Damico still reads on some of the claims and could be modified with an asymmetrical shape as it is known to form the element into a desired shape to fit the passage (evidenced by Hanley, col. 1, lines 38-40).

Regarding arguments to Yamamuro in view of Larsen (and Yamamuro in view of Takabatake in view of Larsen), the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, Yamamuro shows that automobiles have cavities formed by three adjacent metallic members, such as a floor pan, wheel house, rail, or sheet metal. Takabatake and Larsen are applied for their teaching of sealing such cavities from noise and offering reinforcement. Larsen (as well as Takabatake) specifically teaches using the sealing member within cavities in an automobile (such as those disclosed by Yamamuro).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alison K. Pickard whose telephone number is 703-305-0882. The examiner can normally be reached on M-F (9-6:30), with alternate Friday's off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached on 703-308-3179. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1113.

Alison K. Pickard
Examiner
Art Unit 3676

AP